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IN THE

Supreme Court of the United States

OCTOBER TERM, 1978

No. 78-810

SCHOLL, INC.,

Petitioner,

vs.

S. S. KRESGE COMPANY,

Respondent.

OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

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TABLE OF CONTENTS

		PAGE
I.	Statement of the Case	1
II.	There Are No "Special and Important Reasons" for Granting Certiorari Within the Meaning of Rule 19 Rules of the Supreme Court of the United States	3
	A. The Court of Appeals Played a Proper Role in Reviewing the District Court's Findings, and the Decision of the Court of Appeals Will Not Result in a Flood of Appeals	3
	B. A New Use for an Old Device Can Be Patented Only as a Process	4
III.	Conclusion	6

AUTHORITIES

Cases

Exer-Genie, Inc. v. McDonald, 453 F. 2d 132 (9th Cir. 1971) *cert. denied*, 405 U. S. 1075 (1972) 5

Graham v. John Deere Co., 383 U. S. 1 (1966) 3, 4

Statutes

35 U. S. C. § 100(b) 5

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I.

STATEMENT OF THE CASE.

After a two and one-half day trial, the District Court immediately rendered an oral opinion (App. at 8a-9a) holding the patent in suit valid. Subsequently, the trial court adopted (with minor changes) findings of fact and conclusions of law submitted

by attorneys for plaintiff without pretrial or post-trial briefs or closing argument even though the court admitted that it:

> "had enough trouble deciding it [the patent] wasn't an obvious modification of Berkemann . . . ." (App. at 9a)

Defendant filed a Notice of Appeal to the Seventh Circuit Court of Appeals and after the issues were fully briefed and after oral argument was held, the Court of Appeals rendered an opinion on July 14, 1978 reversing the District Court.

The Court of Appeals carefully reviewed the record, including the attorney-drafted findings of the District Court. More specifically, the Court considered:

1. The scope and content of the prior art;[1]
2. The differences between the prior art and the single claim at issue;[2] and
3. The level of ordinary skill in the art.[3]

After this careful review the Court of Appeals considered the critical finding of the District Court that the patented sandal produced "some anatomical advantage and beneficial orthopedic

1. At App. 3a, including footnotes 6 and 7, the Court reviewed the teachings of Dr. Phillip R. Brachman, going back to 1938, and other prior art teachings such as the Levy Mould; Levy, Pod. D., *An Applicance to Induce Toe Flexion On Weight Bearing,* Pages 24, 26, Journal of National Association of Chiropodists, Vol. 40, No. 6, June, 1950; Schuster, Pod. D., *Modifications In The Construction Of The Levy Mould,* Page 33, Journal of National Association of Chiropodists, Vol. 40, No. 6, June, 1950; Levy, Pod. D., *Structural Changes In The Levy Mould,* Page 37, Journal of National Association of Chiropodists, Vol. 41, No. 2, February, 1951. And at App. 4a the Court considered the prior art Stroup patent, as well as a 1941 publication by Musebeck Shoe Company entitled "Your Patient and His Feet". All of these references were found by the District Court to be prior art not before the Patent Office. (App. 16a-17a)

2. At App. 2a the Court noted the differences over the Berkemann design to be "eliminating the part of the ridge under the big toe and providing a slight depression under that toe." At App. 4a the Court noted that these differences were taught by other prior art references.

3. See App. 5a n. 11.

or podiatric effects on the foot as well as promoting increased comfort" and noted its disagreement with this finding:

> "The record is thus extremely weak on the issue of whether the alleged invention produces an orthopedic benefit of any consequence . . . ." (App. at 6a)

Although disagreeing with the finding of an orthopedic benefit,[4] the Court noted that *even if* the evidence was conclusive to support this finding, the patent is still invalid as a *matter of law*:

> "[E]ven if plaintiff's proof on this point had been satisfactory, the patent could not be sustained for a reason to which we now turn." (App. at 6a)

Since the prior art clearly taught lowering the big toe for increased comfort, the Court concluded that:

> "The discovery that the combination also had some orthopedic benefit would not make patentable that which was already in the public domain." (App. at 7a)

II.

THERE ARE NO "SPECIAL AND IMPORTANT REASONS" FOR GRANTING CERTIORARI WITHIN THE MEANING OF RULE 19 RULES OF THE SUPREME COURT OF THE UNITED STATES.

A. The Court of Appeals Played a Proper Role in Reviewing the District Court's Findings, and the Decision of the Court of Appeals Will Not Result in a Flood of Appeals.

The Court of Appeals did not, as suggested by Petitioner, conduct a *de novo* review but, as discussed above, carefully considered the factual inquiries required by *Graham* v. *John Deere Co.*, 383 U.S. 1 (1966). Even if the critical *factual*

4. The Court also stated that the record "undermine[d] Dr. Brachman's opinion and the District Court's finding that the Bittner sandal would not have been obvious to a person ordinarily skilled in the sandal art." (at App. 5a n. 11)

finding (with which the Court of Appeals disagreed) was correct, the District Court erred in going from this factual finding to the ultimate conclusion of nonobviousness and, as this Court has often recognized:

> "[T]he ultimate question of patent validity is one of law . . . ." *Graham* v. *John Deere Co.*, 383 U. S. at 17.

Accordingly, the Court of Appeals' review was clearly proper. Petitioner's complaint that:

> "The activist appellate role asserted by the court below increases the incentives for losing parties to appeal to the Courts of Appeal, adding to their docket burden, and threatening to disrupt emerging solutions to the procedural problems of patent litigation." (Petition for Cert. at 9)

is simply the complaint of every Appellee receiving a judgment of reversal.

In essence, Petitioner is requesting that Courts of Appeal not be permitted to reverse District Court judgments. This, according to Petitioner, would decrease the incentives for losing parties to appeal and would allegedly decrease the docket burden of Courts of Appeal—two results which Respondent is forced to concede would follow from such an absurd rule.[5]

B. A New Use for an Old Device Can Be Patented Only as a Process.

The Petitioner's Brief tries to expand the Patent Act of 1952 to permit the patenting of a new use as an article of manufacture or machine instead of as a process.

5. As to the alleged "emerging procedure" discussed by Petitioner, Respondent respectfully suggests that if this Court's assistance is needed with respect to this procedure, this tribunal should wait for a case in which the "emerging procedure" was utilized. Moreover, Plaintiff's statement at page 11 of Plaintiff's Brief that, "all of the relevant prior art *had* been cited to the Patent Office" is quite curious since four prior art publications not cited by the Patent Office (App. at 17a) were heavily relied on by the Court of Appeals (App. at 3a n. 7 and 4a).

However, 35 U. S. C. § 100, subsection (b) defines "process" as:

> "process, art or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material."[6]

Petitioner, despite the erudite misinterpretation of the Patent Act of 1952, lacks two basic elements necessary to come within that grant:

1. There really was no nonobvious new use of anything since the very same depressed big toe position had been used previously in shoes; and
2. Petitioner's claims were not in the form required by statute; namely, in a "process" form.

Indeed, the most that could be said for the "improvement" even by the misguided District Court was "some anatomical advantage and beneficial orthopedic or podiatric effects on the foot as well as promoting increased comfort". This is hardly a ringing endorsement of a scientific breakthrough of significant proportion.

6. In *Exer-Genie, Inc.* v. *McDonald*, 453 F. 2d 132 (9th Cir. 1971) *cert. denied*, 405 U. S. 1075 (1972), the Court, in footnote No. 1, discussed the effect of the new Patent Act:

> "[A] new use of an old machine may be patented *as a process*. What is not patentable is the old machine itself. *See* Federico, Commentary on the New Patent Act, 35 U.S.C.A. §§ 1,16. Thus, a 'process' may be patented (35 U.S.C. § 101), and 'process' is defined to include 'a new use of a known * * * machine' (35 U.S.C. § 100(b)). But 'it was the intent of Congress to authorize the grant of a patent for a new use** *only when such use is claimed in the form of a process*, art or method. Where an applicant's contribution resides in the use or act of using an old apparatus for new purposes, a claim drawn to the old apparatus does not define the invention to meet the statutory requirement of particularity and distinctness.' 2 Deller's Walker on Patents 293-94 (1964). *See* Application of Hack, 44 C. C. P. A. 954, 245 F.2d 246, 248 (1957). *See also* Gottschalk, "The Term 'Process' * * * Includes a New Use," 40 J. Pat. Off. Soc'y 451, 455-62 (1952)." (emphasis added)

III.

CONCLUSION.

There is no doubt that if the Supreme Court of the United States instructed all Courts of Appeal not to hear questions of validity the workload of the Courts of Appeal would be decreased to that extent.

Also, there is no doubt that had the plaintiff actually invented a nonobvious new use for an old device and expressed it in the form of a process claim he would be entitled to a patent. However, plaintiff did not really invent a new use for an old device, nor did he express it in the form required by the statute.

Hardly are there any special and important reasons why this Court should reconsider the thoughtful and thorough opinion of the Court of Appeals.

Respectfully submitted,

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